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REMARKS

In the Office Action dated March 9, 2006, the Examiner has set forth a requirement for restriction under 35 U.S.C. § 121, alleging that the subject matter defined by the claims of the present invention represents the following three separate and distinct inventions:

Group I. Claims 1-11, 20-31, and 76-83, drawn to an immunogenic/vaccine composition, classified in class 424, subclass 201.1.

Group II. Claims 12-19, and 43-64, drawn to a method of inducing an immune response and treating or preventing a disease, or disorder in an animal subject, classified in class 424, subclass 201.1.

Group III. Claims 32-42 and 65-75, drawn to a method of preventing abortion caused by a virus or preventing persistent fetal infection in an animal, classified in class 424, subclass 202.1.

Examiner also required Applicant to elect a single disclosed species.

In order to be fully responsive to the Examiner's requirement for restriction, Applicant provisionally elects, with traverse, to prosecute the subject matter of Group I, Claims 1-11, 20-31, and 76-83, drawn to an immunogenic/vaccine composition, classified in class 424, subclass 201.1. In addition, Applicant provisionally elects, with traverse, *Leptospira borgpetersenii hardjo-bovis*, as the single disclosed species. Applicant conditionally withdraws claims 12-19 and 32-75 from prosecution, without prejudice, and reserves the right to file one or more divisional applications directed to the non-elected subject matter in this Application.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl 456 F.2d 658, 666, 117 U.S.P.Q. 250,256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting

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claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

In addition, Applicant observes that Groups I-III are all directed to subject matter classified in the same class but different subclasses (class 424, subclasses 201.1 and 202.1). Therefore, it is respectfully submitted that examination of all three groups together, or at least Groups I-II, would not constitute undue burden on the Examiner for the claims of all of the groups to be maintained in a single application. It is respectfully submitted that prosecution of all of these groups of claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice.

Applicant further respectfully suggests that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, *Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co.*, 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double

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patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicant respectfully urges the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims, or at least the claims of Group I and Group II.

Respectfully submitted,



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